

III REMARKS

The Examiner has rejected claims 1–48 under 35 U.S.C. Section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner's rejection is based on two general arguments:

A) Tannin and Tannic Acid are Identical

Applicant has defined tannin as not completely interchangeable with tannic acid. See ***The Merck Index***, Ninth Edition (Merck & Co., Rahway NJ, 1976 (pp. 1172-73), attached as **EXHIBIT A**. See *also* United States Patent No. 5,362,520 to Rodriguez (the "Rodriguez patent"), column 7, lines 31–35, which discloses that the substrate treating material, *i.e.*, a part of the component blend, may be a mixture of tannic acid and vegetable tannins. The definition in the Rodriguez patent is particularly relevant, as it is relied upon as a secondary reference.

B) Tannic Acid, Tannin and Phenol are not evidently GRAS

Applicant's specification identifies under component (b) polyphenol compounds, including tannic acid and tannin as suitable flavoring agents . . . component (d) phenols and their derivatives. (See page 5, lines 17–20, page 6, lines 9–12 and page 7, lines 8–14. The specification does not specifically identify tannin acid, tannin and phenol as GRAS. A copy of the GRAS list is identified in FDA Regulation 21 C.F.R. 172.515 for naturally occurring synthetic flavoring agents (Synthetic Flavoring Substances and Adjuvants) and FDA Regulation 21 C.F.R. 182.20 for natural flavoring agents (Natural

Flavoring Substances and Adjuvants), a copy of which is attached as **EXHIBIT B**. (See Applicant's specification at page 5, lines 8–21).

Accordingly, as tannin and tannic acid have been defined in the art as not completely interchangeable and the support in the specification for tannin, tannic acid and phenol has been identified, the rejection of pending claims 1–10, 12–13, 19–21, 24, 30, 36, 43 and 46–48 on this basis is untenable and should not be made.

Applicant's Response To Rejections Under 35 U.S.C. Section 112

The Examiner has rejected claims 8 and 17–19 under 35 U.S.C. Section 112, first paragraph, as failing to comply with the enablement requirement. In support of this rejection, the Examiner has made the following arguments:

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Treatment, at higher (185g/M², Example 3) concentrations than the general statement (P.26, O. 1-50g/M²) of preferred concentration, was required to control mold, but only with specified agent combination and ratio; but not of the claimed components rather; Lactic acid, propylene glycol and a phenolic essential oil were required, in addition to Benzyl alcohol and Tannin. Example 4A shows PPA 1 is ineffective at 50, Examples 4B, 4C do [show] efficacy, but at higher ratio of tannin (claim 19) than is claimed. However, we do not know what the carrier used to spray was, nor do we know the mold, other than cheese associated. One in the art would not be able to determine whether any of the claimed components and combinations, within the guidelines of the specification, would be anti parasitic when sprayed on wood, or antimicrobial to other than cheese molds. The specifications guidelines are shown to be ineffective as mold control on wood; higher amounts/ concentrations are required. These claims are beyond the scope of the specification. The multitude of claimed inventions, [without] specific guidance as to combination of critical components[,] ratios and amounts applied to protect against specific microbes requires

more testing than one of ordinary skill in the art would be expected to perform in order to determine combinations which of any claimed composition; in fact protects against any of 640,000 or more insect parasite species, or worms, or molds, other than of cheese, when such composition is sprayed on wood.

(Page 2, line 18 to Page 3, line 15).

Most of Applicant's amended claims are directed to compositions consisting essentially of certain specific components, including at least one of the components of the compounds set forth in the EXAMPLES. The components include tannin, benzyl alcohol, propylene glycol, lactic acid and a phenol-containing essential oil. At least one of these components is present in each of Applicant's claimed compositions. The remaining claims that are to compositions "consisting of" include at least benzyl alcohol, propylene glycol, tannin or tannic acid.

Applicant respectfully disagrees with the Examiner's argument that the specification does not disclose to one skilled in the art that compositions comprising one or more of the five referenced ingredients protect wood from mold. The TABLES at pages 36–41 of the specification disclose that a wood superimposed with cheese and treated with Applicant's composition in 100% concentration had no growth in mold for thirty-five days, unlike the wood superimposed with cheese not treated with the composition, which was populated with mold. (See the specification at pages 36–39 and 42). Accordingly, Applicant's claims, which are directed to compositions that protect wood, are enabled by compositions disclosed in the referenced EXAMPLES.

Accordingly, in view of the amendments to the claims and the support for the

efficacy of those claimed compositions in protecting wood, a rejection of the pending claims 1–10, 12–13, 19–21, 24, 30, 36, 43 and 46–48 under 35 U.S.C. Section 112, first paragraph, is untenable and should not be made.

**Applicant's Response To Rejection
Under 35 U.S.C. Sections 102(b) and 103(a)**

The Examiner has rejected claims 1–2 and 4–48 under 35 U.S.C. Section 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. Section 103(a) as obvious over, United States Patent No. 6,207,290 to Blum (the “Blum patent”). The Blum patent is directed to antifoulant compositions that include 10, 10¹-oxybisphenoxarsine and/or phenarsazine oxide with a quaternary ammonium salt as an essential ingredient. Applicant's claimed compositions do not include either of these ingredients. In addition, Blum does not disclose compositions comprising benzyl alcohol, propylene glycol and tannin or tannic acid. Accordingly, as a critical ingredient in the compositions disclosed in the Blum patent is not an ingredient set forth in Applicant's claims, and Applicant's claims are to compositions that consist essentially of the ingredients recited in the claims or to compositions that comprise a combination of benzyl alcohol, propylene glycol and tannin or tannic acid, a rejection of Applicant's claims 1–10, 12–13, 19–21, 24, 30, 36, 43 and 46–48 under 35 U.S.C. Section 102(b) or 35 U.S.C. Section 103(a) over the Blum patent is untenable and should not be made.

Applicant's Response to Rejection Under 35 U.S.C. Section 103(a)

The Examiner has rejected claims 1–48 under 35 U.S.C. Section 103(a) as being unpatentable over the Blum Patent, the Rodriguez patent and United States Patent No. 5,665,432 to Kuwazuru et al. (the “Kuwazuru et al. patent”) and Japanese Patent Publication No. 07-304609 to Kuruzawa et al. (the “Japanese Patent Publication”), in view of Published International Application No. WO 98/54971 to Bessette (“the Bessette application”). The Blum patent has been addressed directly above.

The Rodriguez patent relates to a new and improved bleaching and finishing composition for bleaching and finishing a solid substrate formed from two component blends. Both component blends contain a latex resin. The Rodriguez patent does not disclose compositions comprising benzyl alcohol, propylene glycol and tannin or tannic acid. Accordingly, the Rodriguez compositions are distinct from Applicant's claimed compositions, which consist essentially of compounds that do not include a latex resin or comprise benzyl alcohol, propylene glycol and tannin or tannic acid.

The Kuwazuru et al. patent relates to a process for treating lumber which includes the step of immersing a high moisture content timber in an organic solvent compatible with water. The step is followed by a second step of immersing the timber in a solution comprising a wood preservative and a high boiling point organic solvent, the solution being compatible with the organic solvent. The wood preservatives are identified as wood fungicides, insecticides, insect repellents and so on. See Column 3, lines 25–53 and Abstract). The organic solvent and/or wood preservative and high

boiling point organic solvent does not comprise benzyl alcohol, propylene glycol and tannin or tannic acid.

Applicant's claimed compositions do not include any of the wood preservatives identified in the Kuwazuru et al. patent. Accordingly, as the wood preservative is an essential ingredient in the Kuwazuru et al. compositions and Applicant's claims are to compositions that consist essentially of ingredients which do not include wood preservatives or comprise benzyl alcohol, propylene glycol and tannin or tannic acid, the Kuwazuru et al. patent cannot and does not disclose or even suggest to one skilled in the art Applicant's claimed compositions.

The Japanese Patent Publication is directed to a wood preservative comprising:

(A) triazole compounds, (B) polybasic acid ester compounds chosen from C3-8 organic group esters of phthalic acid, phosphoric acid, sebacic acid, and fumaric acid, (C) alcohol compounds and (D) polyoxyalkylene-based emulsifiers..

In contrast, Applicant's claimed compositions do not include compounds (A) (B) and (D). As the compounds (A), (B) and (D) are essential ingredients of the wood preservative disclosed in the Japanese Patent Publication, the Japanese Patent Publication does not disclose or suggest Applicant's claimed compositions, including compositions comprising benzyl alcohol, propylene glycol and tannin or tannic acid.

The Bessette et al. Published International Application is directed to a pesticide and a method of using the pesticide to kill invertebrates, especially insects, arachnids and larvae. The Bessette method includes preparing a mixture of a carrier with an

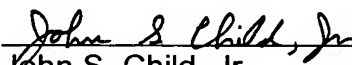
affector agent, which interferes with the neurotransmitters of the octopamine receptor sites in the insects, arachnids and larvae, and applying the mixture to insects, arachnids, larvae and their habitat. In the EXAMPLES section, the preferred blend of affector agent is alpha-terpineol, eugenol and cinnamic alcohol. The carrier is acetone. Alpha-terpineol, eugenol and acetone are not set forth in Applicant's claimed compositions, which consist essentially of certain components. The Bessette et al. Published International Application also does not disclose Applicant's claimed composition comprising benzyl alcohol, propylene glycol and tannin or tannic acids. In addition, the Bessette et al. Published International Application cannot be combined with the other references relied on in the rejection under 35 U.S.C. Section 103(a) to obtain Applicant's claimed compositions for use in preserving wood. There is no motivation provided by the references to obtain Applicant's claimed compositions, which consist essentially of certain components. As noted above, each of the references includes other essential components that are not set forth in Applicant's claims. Furthermore, none of the references exemplifies, or otherwise discloses to one skilled in the art compositions comprising benzyl alcohol, propylene glycol, tannin or tannic acid. Accordingly, a rejection of Applicant's claims 1–10, 12–13, 19–21, 24, 30, 36, 43 and 46–48 under 35 U.S.C. Section 103(a) over the Blum, Rodriguez and the Kuwazuru et al. patents, the Japanese Patent Publication and the Bessette et al. Published International Application would be untenable and should not be made.

IV CONCLUSION

It is believed that the above constitutes a complete response under 37 CFR Section 1.111 and that all bases of rejection stated in the Official Action have been adequately rebutted and/or overcome. Accordingly, a Notice of Allowance of United States Patent Application Serial No. 10/070,042 is requested as the next Office Action. The Examiner is requested to telephone the undersigned attorney if any matters that can reasonably be expected to be resolved in a telephone interview are believed to impede the allowance of the pending claims.

Respectfully submitted,
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